UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte WILLIAM ELLIS LESLIE,
WILLIAM PHILIP SHAOUY
and MATTHEW BUNKLEY TREVANTHAN

_____

Appeal 2008-4229
Application 09/932,163[1]
Technology Center 3600

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Decided:[2] March 20, 2009

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Before SCOTT R. BOALICK, JOHN A. JEFFERY, and MARC S. HOFF,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The real party in interest is International Business Machines Corporation.
[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1, 2, 11-16, 30, and 34-48.

We reverse.

Appellants' invention relates to customizing the content or style of information presented to a user by a server such as an Internet web site. In the course of interacting with the server, the user provides data to the serve that implicitly reveals aspects of his personality. Using such data, the server may categorize the user according to a personality type; in one embodiment, users are categorized according to the Myers-Briggs Type Indicator (MBTI). According to the user's personality type indicator, the content or style of information presented by the serve is customized to suit the personality of the user (Spec. 2-3).

Claim 1 is exemplary:

1. A method for monitoring at least one session over the Internet between a user and a server, said method comprising:

logging occurrences of events that are implicitly relevant to deducing at least one value of each personality type variable of a plurality of personality type variables of a personality type indicator associated with the user during a first session over the Internet between the user and the server, said events consisting of user interactions with Internet web sites that the user visits during the first session;

deducing the at least one value of each personality type variable from the logged occurrences of events by utilizing characteristics of said user interactions with Internet web sites that the user visits during the first session;

recording each value of the deduced at least one value of each personality type variable in a corresponding log that is specific to each value, resulting in a set of logs that comprises the corresponding logs in which said least one value of each personality type variable has been recorded; and

customized a presentation of information from Internet web sites to the user by the server according to a value of the personality type indicator.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| Gerace | US 5,848,396 | Dec. 8, 1998 |
| Breese | US 5,987,415 | Nov. 16, 1999 |

Claims 1, 2, 11-16, and 30[3] stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1, 2, 11-16, and 37-45 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Breese.

Claims 34-36 and 46-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Breese in view of Gerace.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Appeal Brief (filed June 25, 2007), the Reply Brief (filed November 30, 2007) and the Examiner's Answer (mailed November 28, 2007) for their respective details.

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[3] Although the Examiner does not include claim 30 in the statement of this rejection, the Examiner nonetheless includes the claim in the body of the rejection. *See* Ans. 3. Accordingly, we presume that the Examiner intended to include this claim in the rejection.

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ISSUES

There are three principal issues in the appeal before us:

1. Did Appellants show that the Examiner erred in finding that Appellants' disclosure does not enable the claim limitations of "deducing the at least one value of each personality type variable from the logged occurrences of events …" (claims 1 and 37) and "determining the best value of each personality type variable … [by] executing a majority vote algorithm for each log whose associated personality type variable is a binary variable" (claim 13)?

2. Did Appellants show that the Examiner erred in finding that Breese teaches logging occurrences of events that are implicitly relevant to deducing a value of a personality type variable, said events consisting of user interactions with Internet web sites that a user visits?

3. Did Appellants show that the Examiner erred in finding that Breese teaches customizing a presentation of information from Internet web sites to the user according to a value of a personality type indicator?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellants, the invention concerns customizing the content or style of information presented to a user by a server such as an Internet web site. In the course of interacting with the server, the user provides data to the serve that implicitly reveals aspects of his personality. Using such data, the server may categorize the user according to a

personality type; in one embodiment, users are categorized according to the Myers-Briggs Type Indicator (MBTI). According to the user's personality type indicator, the content or style of information presented by the server is customized to suit the personality of the user (Spec. 2-3).

2.   Appellants' Specification discloses deducing the value of a variable by processing the content of logs (Spec. 10:5-16) and describes how the logs acquire the content from which deduction of the value of a variable is performed (Spec. 9:6-16).

3.   Appellants' Specification provides an example of how the value of each of the four MBTI personality type variables may be deduced from user interaction with Internet web sites (Spec. 6-8).

Breese

4.   Breese is directed to constructing a character-based agent based on speech and graphical interactions. Breese uses models of emotions and personality to 1) diagnose the emotions and personality of the user and 2) generate appropriate behavior by an automated agent in response to the user's input (col. 8, ll. 7-11). Breese does this diagnosis by studying (1) word choice and syntactic framing of utterances, (2) speech pace, rhythm and pitch contour, and (3) gesture, expression, and body language (col. 8, ll. 13-16).

5.   Breese teaches that the invention may be practiced in a distributed computing environment, linked by a communications network, which network may be the Internet (col. 7, ll. 59-63).

6.   Breese discloses observing a user's voice (col. 12, ll. 52-53; col. 13, ll. 3-4).

7.   Breese discloses the ability to view and discern a user's facial expressions via a camera (col. 14, ll. 34-36).

8.   The observation interface may monitor the user's inputs to the application from the user's keyboard and mouse (col. 13, ll. 4-6).

Gerace

9.   Gerace teaches using a user's activity with respect to displayed agate information (time-sensitive, reference information that is not read linearly) to determine the behavioral or psychographic profile of a user (col. 1, ll. 8-10; col. 2, ll. 3-10).

PRINCIPLES OF LAW

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

"[A] patent disclosure need not enable information within the knowledge of an ordinarily skilled artisan. Thus, a patentee preferably omits from the disclosure any routine technology that is well known at the time of application." *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1254 (Fed. Cir. 2004).

"'A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.'" *In re Buszard,* 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)).

In an appeal from a rejection for anticipation, the Appellants must explain which limitations are not found in the reference. *See Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) ("[W]e expect that the Board's anticipation analysis be conducted on a limitation by limitation basis, with specific fact findings for each *contested* limitation and satisfactory explanations for such findings.") (emphasis added);*see also In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior

art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR,* 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.,* 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one form of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

ANALYSIS

35 U.S.C. § 112 rejection

With regard to claim 1, the Examiner finds that the claims recite the limitation of "'deducing a value'" of variables, but that the disclosure fails to teach how the "'deducing'" is done (Ans. 3). With regard to claim 13, the Examiner finds that Appellants' disclosure fails to teach how one of ordinary skill in the art would identify what is placed into what category log (Ans. 4).

We do not agree with the Examiner's position. As Appellants explain in the Brief (App. Br. 8-9), Appellants' Specification discloses deducing the value of a variable by processing the content of logs and describes how the logs acquire the content from which deduction of the value of a variable is performed (FF 2). Appellants' Specification provides an example of how the value of each of the four MBTI personality type variables may be deduced from user interaction with Internet web sites (FF 3).

Therefore, because Appellants have shown that the Specification discloses how to deduce the value of personality type variables by logging occurrences of events consisting of user interactions with Internet web sites, Appellants have shown error in the Examiner's rejection of claims 1, 2, 11-16, and 30 under 35 U.S.C. § 112, and we reverse the Examiner's rejection.

35 U.S.C. § 102 rejection

Claims 1 and 37, the only independent claims pending in this application, recite "logging occurrences of events that are implicitly relevant to [determining a user's personality type] … said events consisting of user interactions with Internet web sites that the user visits", and "customizing a presentation of information from Internet web sites to the user by the server according to a value of the personality type indicator."

The Examiner argues that Breese teaches these limitations because Breese teaches that the invention (in which a user's emotional state is assessed by monitoring a user's voice and/or keyboard and mouse input) may be practiced in a distributed computing environment, linked by a communications network (Ans. 8), which network may be the Internet (FF 5).

Breese is directed to constructing a character-based agent based on speech and graphical interactions. Breese uses models of emotions and personality to 1) diagnose the emotions and personality of the user and 2) generate appropriate behavior by an automated agent in response to the user's input (FF 4). Breese does this diagnosis by studying (1) word choice and syntactic framing of utterances, (2) speech pace, rhythm and pitch contour, and (3) gesture, expression, and body language (FF 4). In other words, Breese is directed to monitoring a user's *speech* and *facial expression* in an attempt to discern that user's emotions and personality. Breese discloses observing a user's voice (FF 6). Breese further discloses the ability to view and discern a user's facial expressions via a camera (FF 7). Breese further discloses that the observation interface may monitor the user's inputs to the application from the user's keyboard and mouse (FF 8).

The Examiner combines Breese's teaching of operation over a distributed computing network with the teaching that Breese may monitor keyboard and mouse inputs, and infers that Breese teaches monitoring a user's interaction with an Internet web site (Ans. 8-9).

We disagree with the Examiner's interpretation of Breese. First, Breese does not teach logging occurrences of events that consist of user interactions with Internet web sites. Breese contains no teaching that communication with a user whose voice, face, etc. are to be monitored occurs via a web site interface. Second, it is clear from Appellants' Specification that Appellants' monitoring system monitors a user's interaction with web sites not controlled by or originating from Appellants, as contrasted with Breese, which is directed to monitoring direct communication from the user to the monitoring system. Third, the claim

requires monitoring of user interactions with (plural) web sites. Even if one accepts the Examiner's stated interpretation, Breese teaches monitoring only of a user's communication with Breese's system, not with any other sites or systems.

We further disagree with the Examiner's finding that Breese customizes the presentation of information *from* Internet web sites to the user by a server according to a value of a personality type indicator, as claims 1 and 37 require. First, the Examiner erroneously states that Appellants do not claim customizing the presentation of information *from* web sites (Ans. 10). Second, the Examiner's reliance on Breese's teaching of a computer agent that uses its Bayesian network to determine what emotional and personality state to project to the user (Ans. 10) is misplaced. Such a teaching is not equivalent to a teaching that Breese customizes the presentation of information from web sites. As noted *supra*, Breese contains no teaching that its system communicates with a user via a web interface. Breese further contains no teaching of customizing the presentation of any information, not originating with its own system, to a user. Finally, as with the logging step *supra*, Breese cannot meet the limitation of "customizing a presentation of information from internet web sites" under the Examiner's interpretation, because even under that interpretation Breese only teaches information from a single "web site," i.e., Breese's own system.

Appellants have thus shown that the Examiner erred in finding that Breese teaches logging events consisting of user interactions with Internet web sites, and in finding that Breese teaches customizing presentation of information from Internet web sites to the user. We therefore reverse the

Examiner's rejection of claims 1, 2, 11-16, and 37-45 under 35 U.S.C. § 102.

35 U.S.C. § 103 rejection

Each of claims 34-36 and 46-48 depends from independent claim 1 or independent claim 37, the rejection of which we reverse, *supra*. We therefore reverse the rejection of claims 34-36 and 46-48 under 35 U.S.C. § 103 for the same reasons expressed with respect to parent claims 1 and 37.

CONCLUSIONS OF LAW

Appellants have shown that the Examiner erred in finding that Appellants' disclosure does not enable the claim limitations of "deducing the at least one value of each personality type variable from the logged occurrences of events ..." (claims 1 and 37) and "determining the best value of each personality type variable ... [by] executing a majority vote algorithm for each log whose associated personality type variable is a binary variable" (claim 13).

Appellants have shown that the Examiner erred in finding that Breese teaches logging occurrences of events that are implicitly relevant to deducing a value of a personality type variable, said events consisting of user interactions with Internet web sites that a user visits.

Appellants have shown that the Examiner erred in finding that Breese teaches customizing a presentation of information from Internet web sites to the user according to a value of a personality type indicator.

ORDER

The Examiner's rejection of claims 1, 2, 11-16, 30, and 34-48 is reversed.

REVERSED

KIS

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